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In re Application of	:	
DASSOULAS, Stephen, C., et al.	:	DECISION REGARDING
U.S. Application No.: 09/890,164	:	RENEWED SUBMISSION
PCT No.: PCT/US00/01609	:	UNDER 37 CFR 1.42
International Filing Date: 24 January 2000	:	
Priority Date: 25 January 1999	:	
Attorney's Docket No.: 0275Y0312USB	:	
For: SAW BLADE FOR CUTTING FIBER CEMENT	:	

This decision is issued in response to the "Response" filed by applicants on 24 February 2003. No petition fee is required.

BACKGROUND

The background of this application has been set forth in previous communications mailed by this Office on 18 June 2002 and 24 December 2002.

The 18 June 2002 communication informed applicants that the 22 March 2002 submission of a partially executed declaration was not a complete response to the Notification Of Missing Requirements mailed 12 September 2001.

The 24 December 2002 communication refused applicants' submission of a declaration executed on behalf of deceased inventor Michael Lindberg under 37 CFR 1.42. Specifically, the declaration was found not to comply with 37 CFR 1.497 in that it did not include the citizenship, mailing address, and residence information for the deceased inventor.

On 24 February 2003, applicants filed the "Response" to the previous communication considered herein. The Response correctly notes that the residence and mailing address for the deceased inventor were listed in the Application Data Sheet filed with the application materials. Accordingly, the defect in the filed declaration is reduced to the fact that the declaration executed by the representative of the deceased inventor's estate does not set forth the citizenship of the deceased inventor. Applicants argue that this is not required, asserting that "as long as each inventor, his residence, mailing address and citizenship are 'identified' in at least one of the submitted declarations or in an application data sheet," the declaration is sufficient.

The argument set forth in applicants' 24 February 2003 Response has been considered but is not considered persuasive, as discussed below.

Moreover, a further review has determined that applicants' 22 March 2002 submission in response to the Notification Of Missing Requirements was not a bona fide response in that applicants were clearly aware at the time that the submission was not a complete response to the Notification Of Missing Requirements. Accordingly, this application is **ABANDONED** for failure to file a bona fide response to the Notification Of Missing Requirements, as discussed below.

DISCUSSION

A. Applicants' Response To The 24 December 2002 Communication

Applicants argument here is based on a purported distinction in the regulations regarding "stated" or "identified" facts. However, this argument ignores the language of the controlling statute which these regulations supplement, 35 U.S.C. 115, which expressly states that the applicant "shall state of what country he is a citizen." The listing of the citizenship of the deceased inventor in the application data sheet does not satisfy this requirement (citizenship is not among the items referred to in 37 CFR 1.63(c) as being required unless "supplied on an application data sheet"). Nor is the listing of a country of citizenship for the deceased inventor in declarations signed by the other inventors sufficient, since, in executing these declarations, the inventors are attesting to their own personal information, not that of the other inventors.¹ What is required is that the declaration executed by the person signing on behalf of the deceased inventor set forth the citizenship of the deceased inventor, as the inventor would be required to state under 35 U.S.C. 115.

Accordingly, applicants have still not filed a new declaration in compliance with 37 CFR 1.42 and 37 CFR 1.497, that is, a declaration executed by the representative of the deceased inventor and setting forth the citizenship of both the inventor and the legal representative.

B. Abandonment Based On The Failure To File A Timely Bona Fide Response To The Notification Of Missing Requirements

37 CFR 1.135(c) states the following (bold emphasis added):

When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is, substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirements has been **inadvertently** omitted, applicant may be given a new time period for reply under 37 CFR 1.134 to supply the omission.

¹ Note the first two lines of the declaration, which state: As a below named inventor, I hereby declare that [m]y residence, mailing address and citizenship are as stated below next to my name."

A review of applicants' incomplete 22 March 2002 submission in response to the reveals that the failure to include a full response was not inadvertent. Applicants specifically acknowledged that they had not provided the signature of the deceased inventor's legal representative, stating that such would be provided "shortly."²

Because applicants' failure to file a complete response to the Notification Of Missing Requirements was not "inadvertent," the 22 March 2002 submission cannot be treated as a bona fide response under 37 CFR 1.135, and granting applicants a new time period to respond was therefore improper. See MPEP § 714.03, which states:

The practice set forth in 37 CFR 1.135(c) does not apply where there has been a deliberate omission of some necessary part of a complete reply; rather, 37 CFR 1.135(c) is applicable only when the missing matter or lack of compliance is considered by the examiner as being "inadvertently omitted." For example, if an election of species has been required and applicant does not make an election because he or she believes the requirement to be improper, the amendment on its face is not a "*bona fide* attempt to advance the application to final action.

The Communication mailed by this Office on 18 June 2002 (which treated the 22 March 2002 submission as a bona fide response) and the "Notification Of Defective Response" mailed 02 July 2002 (which granted applicants a new response time for filing a proper declaration) are therefore appropriately vacated.

The application is abandoned for failure to file an acceptable declaration in response to the Notification Of Missing Requirements mailed 12 September 2001.

CONCLUSION

Based on the above, the present application is **ABANDONED**.

The Communication mailed by this Office on 18 June 2002 and the "Notification Of Defective Response" mailed 02 July 2002 are hereby **VACATED**.

As noted above, the declaration filed by applicants on 01 August 2002 remains defective, as discussed above and in the Communication mailed on 24 December 2002, for failure to include the citizenship of both the legal representative and the deceased inventor.

² It is noted that applicants did not submit a declaration executed by the legal representative of the deceased inventor until 01 August 2002.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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